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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,428	08/30/2000	Brian Berson	1697P	2572
7590	06/01/2006		EXAMINER	
Sawyer Law Group LLP P O Box 51418 Palo Alto, CA 94303			HUYNH, CONG LACT	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/651,428	BERSON ET AL.
	Examiner Cong-Lac Huynh	Art Unit 2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 March 2006.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 3/16/06 to the application filed on 8/30/00.
2. Claims 1-20 are pending in the case. Claims 1, 9, and 15 are independent claims.
3. The rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Nielsen has been withdrawn in view of the amendment.

### ***Specification***

4. Please update the serial number of the co-pending U.S. application (line 6).

### ***Claim Objections***

5. Claims 1, 9 and 15 are objected to because of the following informalities: the word "to" is missing before "look up" (claim 1, line 7; claim 9, line 10; claim 15, line 7). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding independent claim 1, embedding a unique identifier included in each of the font specifications in a document at document creation and modification are not disclosed in the specification as claimed.

At document creation, the specification only discloses that "for each font used in the creation of a document, a font file is opened to initiate the font identification (step 20). It should be appreciated that the reference to a font file includes memory resident and network-based (on the Internet) fonts" (page 5, lines 4-6) where "each unique font identification is formed from a single font specification of the value:data pairs" (page 5, lines 17-18). No such embedding is disclosed.

Also, nowhere in the specification discloses said embedding *at document modification*. There is a case, which may be close to embedding, where the specification discloses "once the font specifications are retrieved or calculated, these font specification are written into the document (step 56) and the document is saved (step 58)" (page 9, lines 2-3). However, here, it is clear that the font specifications, *not the unique identifiers as claimed*, are written into the documents, and this is regarding at document saving, not document modification.

Claims 9 and 15 are rejected under the same issue.

Dependent claims 2-8, 10-14, 16-20 are rejected for fully incorporating the deficiencies of their base claims 1, 9 and 15.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (US Pat No. 5,528,742, 6/18/96) in view of Gartland (US Pat No. 6,512,531, 1/28/03, filed 4/9/99).

Regarding independent claim 1, Moore discloses:

- forming a font list, which is equivalent to a font database, for user to select a font to embed in a document (col 4, line 25 col 5, line 9)
- embedding a unique identifier for a font in a document at document creation and modification (col 3, lines 51-60, col 4, line 25 to col 5, line 50, col 7, lines 4-20, col 8, lines 6-52: the font identifier is embedded in a document as a unique identifier when creating document, saving document, and editing document)
- accessing the font database by a viewer when saving and opening documents to ensure usage of proper fonts, the viewer using the appropriate unique font identifier to look up in the font database for accurate font matching (col 5, lines 20-55, col 8, lines 6-52, col 9, line 64 to col 10, line 19)

Moore does not disclose:

- forming a database of font specifications, the font specifications including at least two attributes of a font, each of the font specifications including a unique identifier

Gartland discloses:

- forming a database of font specifications, the font specifications including at least two attributes of a font, each of the font specifications including a unique identifier (figures 3 and 4, col 7, lines 20-31: a font source with font descriptions is a database of font specifications where the font specification includes at least two attributes of a font; information identifying a font implies that each font has a unique identifier)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated Gartland into Moore for the following reason. Gartland

discloses a font description database where each font description includes at least two font attributes providing the advantage to incorporate into the font list, which includes only the font names, in Moore for a font database with complete font information that help viewers to easily determine a font selection via given font characteristics.

Regarding claim 2, which is dependent on claim 1, Moore discloses obtaining a font list for a document being saved, and determining whether font specifications for each font in the font list exist in the database (col 8, lines 6-52).

Regarding claim 3, which is dependent on claim 2, Moore discloses that when the font specifications do exist, the method further comprises retrieving the font specifications for each font from the database (col 4, lines 32-36, col 10, lines 1-19).

Regarding claim 4, which is dependent on claim 2, Moore discloses that when the font specifications do not exist, the method further comprises creating the font specifications for each font (col 10, lines 20-50).

Regarding claim 5, which is dependent on claim 4, Moore discloses writing the font specifications into the document, and saving the document (col 4, lines 49-63: embedding a font file, which includes information regarding the font, to a document and saving said document shows writing the font specifications into the document and saving such document).

Regarding claim 6, which is dependent on claim 1, Moore discloses accessing the database when opening documents further comprises retrieving font specifications from a document being opened (col 5, lines 20-55: retrieving the font identifier from the document being opened, comparing the font identifier against the list of available fonts in an available font list shows accessing the font database).

As mentioned in claim 1, the font list in Moore includes only the font names without more detailed font descriptions as in Gartland. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Gartland into Moore for a font database with complete font information that help viewers to easily determine a font selection via given font characteristics.

Regarding claim 7, which is dependent on claim 6, Moore discloses searching the database to locate each font specified by the font specifications in the document (col 9, line 64 to col 10, line 19: retrieving a font corresponding to the font identifier pointed by the indicator from the permanent storage device and process the document using the retrieved font shows that the font is located and specified by the font identifier).

Regarding claim 8, which is dependent on claim 7, Moore discloses retrieving each font located (col 9, line 64 to col 10, line 19).

Claims 9-14, 15-20 are for a system and a computer readable medium of method claims 1-8, and are rejected under the same rationale.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Teshima (US Pat No. 6,687,879, filed 7/8/99).

Moore et al. (US Pat No. 6,552,728, filed 10/1/98).

Kido (US Pat No. 6,675,358, filed 11/19/99).

Nielsen (US Pat No. 6,665,842, priority 6/23/97).

Cohen et al. (US Pat App Pub No 2002/0054349, priority 9/30/98).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cong-Lac Huynh  
Primary Examiner  
Art Unit 2178  
05/25/06